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THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT
OF THE TTAB

Paper No. 16
DEB

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Dolphin Acquisition Corp. d.b.a. Bare Escentuals

Serial No. 75/008,309

Request For Reconsideration

Michelle D. Kahn of Sheppard Mullin Richter & Hampton, LLP for
Dolphin Acquisition Corp.

Amy L. Alfieri, Trademark Examining Attorney, Law Office 109
(Ronald R. Sussman, Managing Attorney).

Before Hairston, Chapman and Bucher, Administrative Trademark
Judges.

Opinion by Bucher, Administrative Trademark Judge:

Dolphin Acquisition Corp. d.b.a. Bare Escentuals has
requested reconsideration of the Board's April 17, 2001
decision affirming the Trademark Examining Attorney's refusal
to register the mark shown below:

i.d.

for "cosmetics, namely, foundation, blush, eye shadow, lipstick and mascara," in International Class 3.¹ Registration was refused on the ground that applicant's mark, if used on these cosmetic items, so resembles the mark ID, registered for "cologne, perfume and fragrances for personal use,"² as to be likely to cause confusion, to cause mistake or to deceive.

Applicant maintains that during six years of coexistence by these respective marks in the marketplace, there has not been one instance of actual confusion reported to applicant. Further, the argument is made again that applicant offers these goods exclusively through its own stores and over the Internet.

As to the du Pont factor dealing with the length of time during and conditions under which there has been concurrent use without evidence of actual confusion, we have no evidence that these respective marks have ever been used contemporaneously in the same geographical area. As to whether there has been sufficient opportunity for confusion to occur, the record contains no indication of the level of sales or advertising by applicant. Yet the absence of any instances of actual confusion is a meaningful factor only where the

¹ Application serial number 75/008,309, filed on October 20, 1995, based upon an allegation of a *bona fide* intention to use the mark in commerce.

² Reg. No. 2,130,888, issued on January 20, 1998.

record indicates that, for a significant period of time, an applicant's sales and advertising activities have been so appreciable and continuous that, if confusion were likely to happen, any actual incidents thereof would be expected to have occurred and would have come to the attention of one or both of these trademark owners. Similarly, we have no information concerning the nature and extent of registrant's use, and thus we cannot tell whether there has been sufficient opportunity for confusion to occur as we have not had opportunity to hear from the registrant on this point. All of these factors materially reduce the probative value of applicant's argument on the matter of actual confusion. Therefore, applicant's claim that no instances of actual confusion have been brought to applicant's attention is not indicative of an absence of a likelihood of confusion. See Gillette Canada Inc. v. Ranir Corp., 23 USPQ2d 1768, 1774 (TTAB 1992). In any event, we are mindful of the fact that the test under Section 2(d) of the Act is likelihood of confusion, not actual confusion.

We turn then to the applicant's repeated concerns about disparate channels of trade. As we noted in our prior decision:

Applicant has tried to draw a distinction between its goods and those of registrant by characterizing its goods as distributed only through applicant's "Bare Essentials (sic)" chain of retail stores. The difficulty with

applicant's argument is that the identification of goods does not reflect this limitation.

This last sentence contained a footnote as follows:

While applicant offered at the time of its reply brief to amend its identification of goods to include such a restriction, this was much too late in the prosecution of this application for the Office to consider this limitation.

Nonetheless, applicant has now requested that the identification of goods be amended to read as follows:

"cosmetics, namely, foundation, blush, eye shadow, lipstick and mascara, *for distribution only in the BARE ESCENTUALS® retail stores,*" in International Class 3.

However, once an application has been considered and decided by the Board on appeal, an applicant may not amend its application or submit additional evidence (except in two situations that do not apply to this case). See Trademark Rule 2.142(g)³ and TBMP §1218.

Applicant, of course, always retains the option of filing a new application having express limitations on the channels of trade included within its identification of goods.

³ Trademark Rule 2.142(g) reads as follows:

An application which has been considered and decided on appeal will not be reopened except for the entry of a disclaimer under section 6 of the Act of 1946 or upon order of the Commissioner, but a petition to the Commissioner to reopen an application will be considered only upon a showing of sufficient cause for consideration of any matter not already adjudicated.

In summary, for the reasons discussed in our decision as well as those reviewed above, we adhere to our finding that there is a likelihood of confusion with the cited mark.

Decision: The request for reconsideration is denied.